



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,674	03/26/2001	Wolfgang Spahn	051480	3499

9629 7590 04/22/2003

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

KEASEL, ERIC S

ART UNIT	PAPER NUMBER
----------	--------------

3754

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,674

Applicant(s)

SPAHN ET AL.

Examiner

Eric Keasel

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the compensating channel extending along the outer circumference of the pole core (claim 8) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-7, and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kowalski et al. (US Patent Number 2,930,404).

Kowalski et al. disclose a solenoid valve with winding (120), pole core (43), housing (11), spring-stressed flat armature (124), a plunger (126, 130, 98) that passes through the pole core, and a valve member connected to the end of the plunger that controls flow between the pressure inlet (60) and the drain outlet (70). There is a compensating channel leading from the upper to the lower side of the pole core between the plunger and an axial hole of the pole core so that fluid pressure acts on both the upper and lower faces of the pole core.

Art Unit: 3754

4. Claims 1-4, 6, 11, 12, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanamori et al. (US Patent Number 5,476,079).

Kanamori et al. disclose a solenoid valve with winding (44), pole core (40), housing (31), spring-stressed flat armature (43), a plunger (41) that passes through the pole core, and a valve member connected to the end of the plunger that controls flow between the pressure inlet (32a) and the drain outlet (31a, see column 7, lines 8-14). There is a compensating channel (40a) leading from the upper to the lower side of the pole core so that fluid pressure acts on both the upper and lower faces of the pole core (see Fig. 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 3754

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kowalski et al.

Kowalski et al. disclose the compensating channel formed between the plunger and an axial hole of the pole core; however, they fail to disclose the alternate embodiment (not shown in the application) with the compensating channel along the outer circumference of the pole core. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have placed the compensating channel along the circumference of the pole core because applicant has not disclosed that the location of the compensating channel provides an advantage, is used for a particular purpose, or solves a stated problem (in fact, applicant does not even show this alternate placement in the drawings because there is no functional difference). One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either location of the compensating channel because the fluid pressure acts on both faces of the pole core in either situation. Therefore, it would have been an obvious matter of design choice to modify Kowalski et al. to obtain the invention as specified in claim 8.

Response to Arguments

7. Applicant's arguments with respect to claim 1 being anticipated by Kowalski et al. have been considered but are not found persuasive.

Applicant argues that claim 1 requires that compensating pressure on both sides of the pole core be supplied from the drain connection. The examiner disagrees. This is not recited until dependent claim 2. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Art Unit: 3754

Re the drawing objection, applicant states that Fig. 1 shows a gap between the plunger and the inside wall of the pole core. The examiner agrees. This is what is recited in claim 7. However, the drawing objection pertains to claim 8, which recites that the compensating channel extends along the outer circumference of the pole core. This clearly is not shown. So, the drawing objection stands.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Linder et al. disclose a similar valve.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 3754

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

EK 18APR03
ek
April 18, 2003

A handwritten signature in black ink, appearing to read "Gene Mancene", written in a cursive style.

Gene Mancene
Supervisory Patent Examiner
Group 3700